

R E M A R K S

Prior to entry of this Amendment:

- Claims **1-30, 33 and 35** were pending in the present application
- Claims **1-30, 33 and 35** stand rejected
- The Specification and drawings are objected to

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **1-24, 27-30, 33 and 35** will be pending
- Claims 25 and 26 will be canceled
- Claims **1, 30, 33, and 35** will be the only independent claims

A. Claims 25 and 26 Have Been Canceled

We have canceled Claims 25 and 26 without prejudice solely to expedite the allowance of the present application. We intend to pursue the subject matter of those claims in a continuing application.

B. Specification Amendment

The Specification has been amended to indicate a claim to the benefit of priority of U.S. Patent Application No. 09/135,179

In accordance with 37 C.F.R. § 1.78(a), the Specification has been amended to indicate a claim to the benefit of priority of U.S. Patent Application No. 09/135,179, filed August 17, 1998, which issued on May 20, 2003, as U.S. Patent No. 6,567,787 B1 ("Walker"). The present application (filed June 30, 2000) and the prior-filed 09/135,179 application were thus co-pending.

In accordance with 37 C.F.R. § 1.78(a)(1), the prior-filed application 09/135,179 names as an inventor at least one inventor (e.g., Jay Walker) named in the present (later-filed nonprovisional) application, and also discloses the named inventor's invention claimed in at least one claim of the present (later-filed nonprovisional) application in the manner provided by the first paragraph of 35 U.S.C. § 112.

The present (later-filed) application is pending. As the present application was filed under 35 U.S.C. 111(a) before November 29, 2000, we may submit the reference to claim priority at this time without a petition. 37 C.F.R. § 1.78(a)(2)(ii)(B).

We make this claim solely in order to expedite prosecution.

U.S. Patent Application No. 09/135,179 was already incorporated by reference

The amended text includes a statement that U.S. Patent Application No. 09/135,179 is incorporated by reference. We note that U.S. Patent Application No. 09/135,179 was already incorporated by reference in the present application in a paragraph directed to related applications (see page 1). Thus, the Amendment merely re-copies the incorporating reference as it applies to U.S. Patent Application No. 09/135,179 and does not add any new matter.

C. All of the Section 102(e) and Section 103(a) Rejections Are Overcome

All of the pending claims (Claims 1-30, 33 and 35) stand rejected under 35 U.S.C. 102(e) as being anticipated by Walker. [Office Action, pages 2-5]. All of the pending claims (Claims 1-30, 30 and 35) also stand rejected under Section 103(a) in light of Walker alone or in combination with various references. [Office Action, pages 4-5 (alternative rejection of Claims 25 and 26); 5-11 (all of Claims 1-30, 33 and 35)].

Thus, all of the Section 102(e) and Section 103(a) rejections rely on Walker.

However, the Section 102(e) and 103(a) rejections are moot in light of this Amendment to claim the benefit of Walker. As priority of the present application has been perfected by this Amendment, Walker is no longer prior art under Section 102(e). See MPEP § 706.02(b) "Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent [R-1]."

We are grateful to the Examiner for bringing the 09/135,179 application (Walker) to our attention. We respectfully request that the Examiner withdraw all of the Section 102(e) and 103(a) rejections.

D. Correction to Inventorship

We will be submitting a request under 37 C.F.R. § 1.48 to correct inventorship to include the additional inventors of the 09/135,179 application.

E. Summary of Telephone Interview

We are grateful for the Examiner's courtesy in conducting a telephone interview with our representative on July 20, 2004.

The Examiner and our representative discussed the objection to the Specification and drawings. [See, Office Action, page 2]. The Examiner agreed

that the subject matter of Claim **25** is adequately described in the Specification, at least because Claim **25** was originally filed and has not been amended. The Examiner stated that Claim **25** is not enabled by the Specification, however.

F. Objection to Specification / Enablement Rejection

The Examiner objects to the Specification and drawings “because they do not appear to provide a basis for claim 25. It is not clear how a plurality of potential offers are determined and how one is selected by the attendant.” [Office Action, page 2].

In the telephone interview, the Examiner clarified his position regarding Claim **25**. We understand that the Examiner believes that the subject matter of Claim **25** is described in the Specification (at least because Claim **25** was originally filed and has not been amended), and the Examiner also believes the subject matter of Claim **25** is not enabled by the disclosure.

To the extent that the Examiner intended to reject Claim **25** under 35 U.S.C. § 112, first paragraph for lack of enablement, we dispute that the claimed subject matter of determining a plurality of potential offers based at least in part on the verbal response and prompting an attendant to select a selected offer from among the plurality of potential offers is not described in the present disclosure clearly enough to enable one of ordinary skill in the art to make or use the embodiments claimed in Claim **25**. For example, examples of offers are depicted in FIG. 5 as exemplary employee responses.

However, Claims 25 and 26 have been cancelled by this Amendment solely in order expedite prosecution. Accordingly, the Examiner’s objection / rejection is moot.

For at least the reasons stated herein, we respectfully request allowance of the pending Claims **1-24, 27-30, 33 and 35**.

G. Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,



Michael Downs
Attorney for Applicants
Registration No. 50,252
Walker Digital, LLC
mdowns@walkerdigital.com
(203) 461-7292 /voice
(203) 461-7300 /fax

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